

Remarks

Amendments to the Claims

Claim 1 has been amended to recite an alpha olefin feed consisting essentially of 1-dodecene. Support for such amendment can be found in the specification at original claim 1, at the paragraph bridging pages 4 and 5, at the paragraph bridging pages 5 and 6, and at page 6, lines 13-27. The phrase "composition" has been deleted to provide for consistent terminology throughout the claims regarding the base oil.

Support for the amendment to claim 2 can be found in the specification at original claim 2 and at the paragraph bridging pages 5 and 6. The phrase "composition" has been deleted to provide for consistent terminology throughout the claims regarding the base oil.

Claim 3 has been amended to recite that the alpha olefin feed consists essentially of at least 85% by weight 1-dodecene. Support for such amendment can be found in the specification at the paragraph bridging pages 4 and 5. The phrase "composition" has been deleted to provide for consistent terminology throughout the claims regarding the base oil.

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Support for the amendments to claims 6-9 can be found in the specification at original claims 6-9, at the paragraph bridging pages 4 and 5, at the paragraph bridging pages 5 and 6, and at page 6, lines 13-27.

Support for the amendments to claim 13 can be found in the specification at original claim 13 and at the same cites as recited above for the amendments to claim 1.

Claim 14 has been amended to recite proper antecedent language.

New claims 15-28 are drawn, in part, to an alpha olefin feed consisting essentially of 1-tetradecene to help render moot the 35 U.S.C. §103(a) rejections. Support for such new claims can be found in the specification at original claims 1-14 and at the same cites recited above for support for the amendments to claims 1-14. Applicants respectfully suggest that the amendments to claims 1-14 and the addition of new claims 15-28 help render moot the 35 U.S.C. §103(a) rejections by clarifying that Applicants' recited alpha olefin feed consists essentially of either 1-dodecene or 1-tetradecene, but not both 1-dodecene and 1-tetradecene. Applicants respectfully suggest that the claims now recite an alpha olefin feed which is not a mixture of 1-dodecene and 1-tetradecene.

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Applicants respectfully suggest that the amended claims and the new claims, when viewed in light of the specification such as in the paragraph bridging pages 4 and 5 and at page 6, lines 13-27, recite an alpha olefin feed consisting essentially of either 1-dodecene or 1-tetradecene and not a mixture of 1-dodecene and 1-tetradecene.

The specification, at page 4, line 30 - page 5, line 2, discloses that the phrase "consists essentially of" or "consisting essentially of" is intended to mean the exclusion of other elements of any essential significance to the composition. The specification, at page 5, lines 2-5, further discloses that the phrase "consisting essentially of either 1-dodecene or 1-tetradecene" refers to a feed which contains at least 85% by weight of 1-dodecene or 1-tetradecene. Applicants respectfully suggest that when Applicants' alpha olefin feed consists essentially of 1-dodecene, the remainder of such alpha olefin feed does not contain 1-tetradecene, but contains "other alpha olefins" as recited in the specification at page 6, lines 13-24. Similarly, when Applicants' alpha olefin feed consists essentially of 1-tetradecene, the remainder of such alpha olefin feed does not contain 1-dodecene, but contains other alpha olefins.

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Applicants respectfully suggest that when 1-dodecene is present in Applicants' alpha olefin feed, then the presence of 1-tetradecene would be considered an element of essential significance to the composition. Similarly, when 1-tetradecene is present in Applicants' alpha olefin feed, then the presence of 1-dodecene would be considered an element of essential significance to the composition. Thus, the phrases "consisting essentially of" and "consists essentially of", when referring to Applicants' alpha olefin feed, indicates the presence of 1-dodecene or 1-tetradecene, but not both 1-dodecene and 1-tetradecene.

Applicants respectfully suggest that the amendments to the claims are fully supported by the application as originally presented and should not be considered new matter.

Claim Rejections Under 35 U.S.C. 103(a) in View of Benda '863

Claims 1-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Benda et al. (U.S. 6,071,863) ("Benda").

Applicants respectfully traverse the 35 U.S.C. §103(a) rejections as such rejections pertain to the cited claims. Reconsideration and withdrawal of the rejections are respectfully requested in view of the amendments to the claims and the following remarks.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See MPEP §2143. See also *In re Vaeck*. 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Circ. 1991).

Benda discloses a polyalphaolefin fluid prepared from a mixture of C₁₂ and C₁₄ alphaolefins. See Benda Abstract, column 1, lines 5-9, column 1, lines 36-65, Examples 1 and 2 at columns 3-5, and claim 1. Further, the Office Action states that Benda discloses biodegradable polyolefin fluids comprising oligomers of mixtures of dodecene and tetradecene alpha olefins. The Office Action further states that Benda teaches that substantially pure 1-dodecene and 1-tetradecene are mixed

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before oligomerization by known methods. See Office Action at page 2, third full paragraph.

Applicants respectfully suggest that there is no suggestion or motivation in Benda or in the knowledge generally available to one of ordinary skill in the art to modify Benda, which requires a mixture of dodecene and tetradecene with no anticipation, disclosure, or suggestion that such Benda polyolefin fluids could be produced without such mixture, to arrive at Applicants' claimed invention of use of an alpha olefin feed consisting essentially of 1-dodecene or use of an alpha olefin feed consisting essentially of 1-tetradecene.

Applicants also respectfully suggest that there is no reasonable expectation of success of producing a base oil from an alpha olefin feed consisting essentially of 1-dodecene or consisting essentially of 1-tetradecene in view of Benda which requires a mixture of dodecene and tetradecene.

Applicants also respectfully suggest that Benda does not teach or suggest all of Applicants' claim limitations such as an alpha olefin feed consisting essentially of 1-dodecene, or an alpha olefin feed consisting essentially of 1-tetradecene, or a base oil derived from such feeds.



Applicants respectfully request that this application be re-examined in light of the above amendments and remarks. Applicants further respectfully request that the rejections under 35 U.S.C. §103 be withdrawn and that claims 1-28 be allowed.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on

April 16, 2001

(Date)

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